

REMARKS/ARGUMENTS

This Amendment is in response to the Office Action mailed January 26, 2009. Claims 20-32 were pending in the present application. This Amendment amends claim 25, adds new claims 33-38 without canceling any claims, leaving pending in the application claims 20-38. Reconsideration of the rejected claims is respectfully requested.

On April 16, 2009, an interview occurred between the undersigned Applicant's representative and the Examiner. During the interview, the subject matter of Applicant's claims was discussed, and contrasted with the cited art. Applicant sincerely and earnestly thanks the Examiner for her careful consideration of the arguments presented.

I. Rejection under 35 U.S.C. §103

Claims 20-32 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Freeman* (United States publication number 2007/0260980). This rejection is traversed.

A. *Freeman* does not render the independent claims of the present Application obvious because it does not teach or suggest, *inter alia*, archiving or generating electronic image data at the time the email document is created as recited in the claimed subject matter.

The Office Action alleges that *Freeman* renders the subject matter of the independent claims 20, 22, 25 and 29 obvious. However, *Freeman* does not render the independent claims of the Application obvious because it does not teach or suggest all claim limitations. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. Here, *Freeman* does not teach or suggest generating electronic image data as recited in all independent claims of the Application.

The Office Action alleges, "the images of the email documents transmitted over the network are in the form of the electronic images of the email documents like the electronic documents (paragraph [0013]), electronic versions (paragraph [0080]), electronic checks, deposits, securities transactions, report (paragraph [0089]) are all stored in the main stream so that data is widely and automatically accessible anywhere and compatibility access platforms

(paragraph [0018]).” Applicants respectfully disagree with these interpretations of the passages cited in *Freeman*.

For example, paragraph [0013] of *Freeman* states:

A further object of the present invention is to provide an operating system which takes advantage of the nature of electronic documents. For example, a conventional paper document can only be accessed in one place, but electronic documents can be accessed from multiple locations.

Then in paragraph [0018], *Freeman* states:

Another object of the present invention is to provide an operating system in which personal data is widely accessible anywhere and compatibility across platforms is automatic. Accordingly, this invention provides that computers using the operating system of the present invention need not be independent data storage devices, but also act as “viewpoints” to data stored and maintained on external systems such as the INTERNET. Thus, in accordance with the present invention users can access their personal documents streams from any available platform such as a UNIX machine, a Macintosh, or IBM-compatible personal computer, a personal digital assistant (PDA), or a set-top box via cable.

Paragraph [0080] states, “In the following embodiments a stream naturally provides a structure for storing technical [and] electronic versions of a newspaper or magazine.” While Paragraph [0089] states:

Another embodiment of the present invention organizes a user’s personal finance. Large number[s] of users already track their checking accounts, savings, investments, and budgets with applications such as QUICKEN. The types of records and documents used in these applications such as electronic check, deposits, securities transactions, reports are conveniently stored and generated in streams.

As such, it appears that the Office Action has cited various words and phrases from the above listed passages in the allegation that, “the images of the email documents transmitted over the network are in the form of the electronic images of the email documents like the electronic

documents (paragraph [0013]), electronic versions (paragraph [0080]), electronic checks, deposits, securities transactions, report (paragraph [0089]) are all stored in the main stream so that data is widely and automatically accessible anywhere and compatibility access platforms (paragraph [0018]).” However, the Office Action fails to make a proper *prima facie* case as to how such teachings would render the pending claims obvious. The statement “the electronic images of email documents like the electronic documents, electronic versions, electronic checks...” in the Office Action simply likens the electronic nature of various forms of electronic data. There is no recognition of the difference between electronic image data and other electronic data. The Office Action does not appear to consider the relationship between the copy of the email document and the electronic image data generated therefrom in the claimed subject matter. It is clear that not all electronic document types are the same and, as such, the allegation to the contrary is in error.

Additionally, the pending independent claims recite, *inter alia*, “receive a copy of every email document transferred over the network” and “cause electronic image data to be generated for each received copy of an email document.” The Office Action does not appear to consider at least the limitation “cause electronic image data to be generated.” Even if it can be interpreted, *arguendo*, that the electronic images of email documents are equivalent to electronic documents, electronic versions, electronic checks, etc., as alleged in the Office Action, the rejection is still insufficient.

The Office Action does not point to anywhere in *Freeman* that teaches or suggests why it would be obvious from the disclosure to “cause electronic image data to be generated for each received copy of an email document” as recited in the pending independent claims. This step is simply not taught or suggested in *Freeman*. The Examiner, on page 4 of the Office Action and during the telephone interview, seems to interpret the generation of electronic image data of an email document is the same as copying, duplicating or cloning email documents. As explained during the interview, as used in the art, such functions, especially when conducted electronically, are not the equivalent of, nor do they suggest a function similar to, generating electronic image data of an email document. As such, *Freeman* does not and cannot render the claimed subject matter obvious.

As discussed of record, if an email is received and a copy of that email is made in the same format, that is not the same as generating an image document in an image format (*i.e.*, a JPG), where the image document includes an image of the email document. For example, copying a text document to another text document, thus creating another instance of the text document, is not the same as generating an image based on the text document. A rejection under §103 requires that the limitation be taught or suggested in the reference in order for the reference to render a claim obvious, and *Freeman* does not teach or suggest generating an image for every received email document and storing the generated image for every email document. Since *Freeman* does not teach or suggest each limitation, it does not render the claimed subject matter obvious.

Furthermore, the Office Action explicitly acknowledges, "*Freeman* does not directly teach a database to store electronic copies of [documents] transferred over the network." The Office Action then goes on to allege, "*Freeman* teaches [every] document created and every documents [sent] to a person or entity is stored in a main stream. It would have been obvious to one skilled in the art at the time the invention was made to consider the main stream taught in *Freeman* equivalent to a database claimed since both of them [store] electronic copies of documents transferred over the network which results in the same result." Applicants respectfully disagree with this allegation of equivalence.

As discussed of record, *Freeman* discloses a new model for operating systems that stores information according to a "time-ordered stream," instead of standard filename and file folder-based approaches (paragraph [0032]). A document stream has three main portions - "past, present and future," where the "present" portion holds working documents saved to the system, and older documents that are still saved to the system after some amount of time enter the "past portion" where the documents are eventually archived (paragraph [0044]). This is very different from what is recited in the independent claims.

For example, claim 20 recites that steps including generating electronic image data and archiving the generated image data are carried out at substantially a time that the email document is transferred over the network." As discussed with the Examiner during the telephone interview conducted on April 16, *Freeman* only archives documents that are in the system for some

determined amount of time, and unless documents are saved to the system after that amount of time, those documents are not archived. As such, just because the operating system of *Freeman* saves a document does not mean it automatically archives each such document, and it is clear that it does not archive documents at substantially the same time as the document (or a copy of a document) is received as recited in claim 20. *Freeman* thus does not teach or suggest these limitations of claim 20.

Finally, to expedite prosecution, claim 25 has been amended to recite, *inter alia*, “causing the document management device to generate electronic image data for each copy of an email document, the electronic image data being generated in a compressed image format.” This limitation is not taught or suggested in *Freeman*, which only teaches copying, cloning and sending electronic files. As such, *Freeman* does not teach or suggest each limitation of the claimed subject matter of independent claim 25 and therefore *prima facie* obviousness has not been established.

For at least these reasons, independent claims 20 and claim 25 are not obvious over *Freeman*. Furthermore, claims 22 and 29 which comprise limitations similar to those in claim 20, are rejected for the same rationales set forth for claims 20 and 25. As such, claims 22 and 29 are also not obvious over *Freeman* for at least the reasons set forth above in reference to claim 20. Applicants therefore respectfully request that the rejections under §103 with respect to these claims be withdrawn.

B. The allegation that *Freeman* renders the independent claims of the Application obvious is improper because the Office Action does not explicitly set forth a clear articulation why the claimed subject matter would have been obvious, but rather relies on mere conclusory statements contrary to the requirements of MPEP §2143.

The allegation that *Freeman* teaches, “the images of the email documents transmitted over the network are in the form of the electronic images of the email documents like the electronic documents (paragraph [0013]), electronic versions (paragraph [0080]), electronic checks, deposits, securities transactions, report (paragraph [0089]) are all stored in the main stream so that data is widely and automatically accessible anywhere and compatibility access

platforms (paragraph [0018])" is improper because the Office Action does not make explicit the underlying logical rationale for the allegation. Such conclusory statements are not proper according to the MPEP.

MPEP §2143 states:

The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Federal Circuit has stated that "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396.

The statement "the electronic images of email documents like the electronic documents, electronic versions, electronic checks..." does not follow logically or factually. Electronic image data is not the same as the other formats recited on page 4 of the Office Action. Therefore, it is not rational to allege that by reciting these other formats in various unconnected passages that *Freeman* somehow suggests generating the electronic image data from the copy of email document as recited in the claimed subject matter. The Office Action only states in an incorrectly and conclusory manner that electronic images of emails are the same as electronic documents, electronic versions, electronic checks, etc. As such, the allegation does not state an articulated reasoning with some rational underpinning to support a legal conclusion of obviousness, as required by *KSR* and the MPEP.

Furthermore, the allegation on page 4 of the Office Action that "it would have been obvious to one skilled in the art at the time the invention was made to consider the storing or archiving of the images of the email documents (copies, duplicated or cloning of the email documents) is automatic or unconscious archiving since *Freeman* teaches that the storing of the electronic documents in the main stream (and not sub-streams) is automatic and transparent to the user," not only comprises an erroneous interpretation of *Freeman*, but is also improper. To allege that simply because elements of the claimed invention may have been individually known

in the art is insufficient to establish obviousness.

Section IV of MPEP §2143.01 states

A statement that modifications of the prior art to meet the claimed invention would have been “well within the ordinary skill of the art at the time the claimed invention was made” because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). “[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396 quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006).

As stated during the interview with the Examiner, generating image data of email documents is not the same as the copying or cloning of documents files in *Freeman*. As discussed above, if an email is received and a copy of that email is made in the same format, that is not the same as generating an image document in an image format (*i.e.*, a JPG), where the image document includes an image of the email document. Therefore, basing conclusory obviousness rejection on the faulty factual premise compounds the error of the rejection under §103 because the Office Action does not set forth an objective reason to modify the teaching of *Freeman's* operating systems that stores electronic documents in a stream to arrive at the email server or method for archiving electronic image data of the claimed subject matter.

For at least these reason, Applicants respectfully submit that rejection under §103 is improper.

C. The dependent claims of the Application are also allowable.

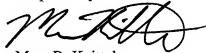
Dependent claims 21, 23, 24, 26-28, 30-35 depend from allowable subject matter as discussed above, and include additional allowable subject matter. Applicants respectfully request that the rejections with respect to the dependent claims also be withdrawn.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 925-472-5000.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'M. Knittel', written over a horizontal line.

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